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REMARKS

Claims 1-18 are pending in the application. Claims 4-7 and 9-14 have been withdrawn from consideration as being drawn to nonelected subject matter. Claim 1-3, 8 and 15-18 are rejected. Claims 1-3 have been amended. Applicants respectfully request reconsideration.

Claims 1-3, 8 and 15-18 were rejected under 35 U.S.C. §102(e) as being anticipated by Lahm et al. (US 2005/0075372) and Berger et al. (US 2004/0209923). Applicants respectfully traverse this rejection.

Example 6 of Berger et al. was pointed to by the Examiner. Example 6 lacks the present CN substituent and thus does not overlap with the presently claimed compounds.

The Examiner stated that Lahm et al. and Berger et al. specifically disclose the instant compound wherein R³ is Cl, R⁷ is H, R² is CF₃, R⁴ is iso-propyl and R⁵ is H and noted Compound 779 of Lahm et al. In order to expedite prosecution, Applicants have amended Claim 1 to remove subject matter wherein R² is C₁-C₄ haloalkyl.

In view of the above, Applicants respectfully submit that Claims 1-3, 8 and 15-18 are not taught by Lahm et al. and Berger et al.

Claims 1-3, 8 and 15-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combined teachings of Lahm et al. and Berger et al. Applicants respectfully traverse this rejection.

Applicants bring to the Examiner's attention the fact that Lahm et al., Berger et al. and the present invention were owned by the same entity at the time the present invention was made; all were assigned or subject to an obligation of assignment to E. I. du Pont de Nemours and Company. Accordingly, Applicants respectfully request that the rejection of Claims 1-3, 8 and 15-18 under 35 U.S.C. §103(a) be withdrawn.

Claims 8 and 16 were rejected under 35 U.S.C. §112, first paragraph, as nonenabling for the treatment of pests such as bacteria, fungi, bacteria etc. Applicants respectfully traverse this rejection.

As defined in paragraph [0138] of page 20 of the present specification which published as US 2006/0111403A1, the term "invertebrate pest" includes arthropods, gastropods and nematodes of economic importance as pests. Note that the terms "bacteria" or

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fungi” do not appear in the definition. According to modern biological classification, bacteria, fungi and invertebrate animals (pests) are classified into three different Kingdoms: Monera, Fungi and Animalia, respectively. Accordingly, Claims 8 and 16 do not claim a method for control of bacteria or fungi.

In the present specification, a wide variety of application methods useful for controlling invertebrate pests are disclosed, e.g. see page 24, paragraph [0145] to page 25, paragraph [0149]. In addition, detailed procedures for the control of invertebrate pests are illustrated by the Biological Examples, Tests A-I, on pages 27-29. Applicants therefore maintain that the present disclosure does indeed provide sufficient enablement for the control of invertebrate pests and respectfully submit that Claims 8 and 16 meet all the requirements of 35 U.S.C. §112, first paragraph.

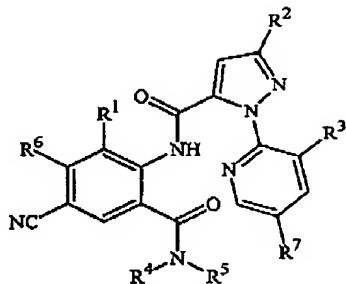
Claims 8 and 16 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 17 of copending Application No. 10/483,115. Applicants respectfully traverse this rejection.

Applicants maintain that present Claims 8 and 16 are patentably distinct from Claims 1-5 and 17 of copending application 10/483,115. Lahm et al. claims a method for controlling particular insect pests involving contact with a compound of a generic formula that embraces present Claims 8 and 16. Nevertheless, the broad disclosure and claims of Lahm et al. do not teach or lead one skilled in the art to the present invention.

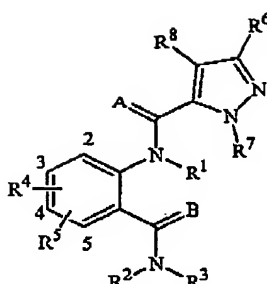
For example, R⁷ of Lahm et al. Formula I can be, *inter alia*, alkyl, alkenyl, alkynyl or cycloalkyl, or optionally substituted phenyl, benzyl, 5- or 6-membered heteroaromatic ring, a naphthyl ring system or an aromatic 8-, 9- or 10-membered fused heterobicyclic ring system; whereas compared to this broad description, the compounds of the present method comprise a pyridine ring with two precisely positioned substituents. Furthermore the phenyl ring of Lahm et al. can be either unsubstituted, mono-substituted or di-substituted with a wide range of substituents; whereas the phenyl ring in the compounds of the present method is di- or tri-substituted with CN and a small number of additional substituents in precise positions.

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Formula 1 compounds
of present invention



Formula I of Lahm et al.

Only Claim 3 of Lahm et al. narrows the selection of R^7 to optionally substituted phenyl or 2-pyridinyl. However, this claim also specifies substituent R^4 to be attached at the 2-position and be selected from CH_3 , CF_3 , OCF_3 , OCHF_2 , CN or halogen, and the other substituent R^5 to be H, CH_3 or halogen. Therefore Claim 3 of Lahm et al. teaches towards placing the CN substituent at the 2-position instead of the instant 4-position. Accordingly Lahm et al. teaches away from the present invention.

It is well known in the art that the invertebrate pest control activity of organic compounds are a function of numerous factors relating to physical properties (such as size, shape, solubility, lipophilicity, etc.) and biochemical properties (such as transport, binding, metabolism, etc.). Given this complexity, it is not always possible for the skilled artisan to predict the activity and hence the particular utility of even seemingly closely related compounds. Even moving a substituent a single carbon position can have a substantial effect on the stereoelectronic profile of a molecule and its biological utility. The difference between the 2-position of Lahm et al. Claim 3 and the present 4-position involves a shift of multiple positions.

Furthermore, Lahm et al. does not specifically disclose test results or any other evidence of invertebrate pest control utility for compounds having CN at the 2-position and indeed does not name any such compound. The only compound having CN on phenyl for which utility is demonstrated is Compound 779 wherein the CN is at the 4-position. Present Claims 8 and 16 do not embrace a method using this compound or its haloalkyl homologs. Therefore the disclosure and claims of Lahm et al. including Compound 779 do not teach, suggest or otherwise lead one skilled in the art to control invertebrate pests by contact with the particular compounds described in present Claims 8 and 16. Applicants respectfully submit that Claims 8 and 16 are nonobvious and patentably distinct over Lahm et al. and request removal of this rejection.

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Claims 8 and 16 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 24 of copending Application No. 10/485,125. Applicants respectfully traverse this rejection.

Applicants maintain that present Claims 8 and 16 are patentably distinct from Claims 1-5 and 24 of copending application 10/485,125. Berger et al. claims a method for protecting a propagule or a plant grown therefrom from an invertebrate pest involving contact with a compound of a generic formula that embraces present Claims 8 and 16. Nevertheless, the broad disclosure and claims of Berger et al. do not teach or lead one skilled in the art to the present invention.

Applicants' comments above with regard to the provisional rejection of Claims 8 and 16 in view of claims 1-5 and 17 of copending Application No. 10/483,115 are applicable in response to this provisional rejection, as well, a difference being that the only compound having CN on phenyl for which utility is demonstrated is Compound 772 wherein the CN is at the 4-position (see the last compound on page 127 of US 2004/0209923). In view of the above, Applicants respectfully submit that present Claims 8 and 16 are not suggested and are patentably distinct from claims 1-5 and 24 of copending Application No. 10/485,125 and request that this rejection be withdrawn.

It was noted that the application does not contain an abstract of the disclosure. Applicants herein provide an Abstract on a separate sheet.

Applicants respectfully point out that in the Information Disclosure Statement mailed by Applicants on December 6, 2005, on sheet 1 of 3, none of the FOREIGN PATENT DOCUMENTS were initialed as having been considered. Applicants respectfully request that the Examiner initial this section of the sheet to indicate consideration of these documents.

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In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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